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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,454	09/15/2003	James D. Murray	UCAL-286	4027
24353	7590	12/30/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			HAMA, JOANNE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/663,454	Applicant(s) MURRAY ET AL.	
	Examiner Joanne Hama, Ph.D.	Art Unit 1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 06 October 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): 112, 1st, written description.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 3, 5, 13-15, 17-21, 33, 35, 36, 38-43.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☐ Other: _____.

Q. JANICE LI, M.D.
PRIMARY EXAMINER


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Applicants filed a response to the Advisory Action of November 2, 2005 on December 1, 2005. Claims 1, 3, 5, 13-15, 17-21, 33, 35, 36, 38-43 are pending. It is noted that the Advisory Action of November 2, 2005 had inadvertently left off claims 13 and 14 from the rejection. These claims are pending and are rejected.

Withdrawn Rejection

35 U.S.C. § 112, 1st parag., Written Description

Applicant's arguments, see pages 9-12 of Applicant's response, filed December 1, 2005, with respect to the rejection of claims 1, 3, 5, 13-15, 17-21, 33, 35, 36, 38-43 under 35 U.S.C. § 112, 1st parag., Written Description have been fully considered and are persuasive. It is noted that the Applicant has pointed out, page 12, that the claimed invention has been narrowed to mammary gland promoter, for which there is written description support in the art. Regarding the written description support for fatty acid desaturases, the Examiner finds the argument persuasive as the Applicant has indicated that at the time of filing, fatty acid desaturases were characterized in a variety of animals (e.g. see Pereira et al., 2003, Prostaglandins, Leukotrienes, and Essential Fatty Acids, 68: 97-106). The rejection of claims 1, 3, 5, 13-15, 17-21, 33, 35, 36, 38-43 has been withdrawn.

Maintained Rejection

35 U.S.C. § 112, 1st parag. Enablement

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Applicant's arguments filed December 2, 2005 have been fully considered and they are persuasive in part.

Applicant has indicated that the Office Action of September 2, 2004 had enabled the scope of mammary gland tissue promoter. The Applicant had amended the scope of the claimed invention to that embodiment October 6, 2005. With regards to the rejection as it applies to the mammary gland tissue promoter, the rejection is withdrawn. Subsequently, the rejection regarding the making of non-human mammals by nuclear transfer is withdrawn.

Regarding the scope of PUFAs, the Applicant has correctly indicated that conjugated linoleic acid is a PUFA. The rejection regarding this issue is withdrawn.

However, with regards to the rejection over the broad scope of any fatty acid desaturase, the Examiner does not find the Applicant's argument persuasive. While the Applicant has provided guidance as to what characteristics fatty acid desaturases have, neither the art nor the specification provide guidance as to how select fatty acid desaturases from other species of animals such that they can be used in the claimed mammal. For example, Pereia et al., 2003, Prostaglandins, Leukotrienes, and Essential Fatty Acids, 68: 97-106 teach that some insects have delta12 desaturase activity, but many animals do not have this ability (Pereia et al., page 99, 1st parag. under, "delta12 desaturase and omega-3 desaturase"). As this situation applies to the claimed invention, in light of the teachings of Hammer et al., an artisan cannot predict that one can take any transgene construct comprising any nucleic acid sequence

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encoding any desaturase, e.g. such as a delta12 desaturase from the cockroach, and predict that it would have activity in milk. Thus, claims 1, 3, 5, 13-15, 17-21, 33, 35, 36, 38-43 remain rejected.

While the After Final of December 1, 2005 has been considered as a courtesy, it is noted that normally supplemental replies will not be entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii).

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is 571-272-2911. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

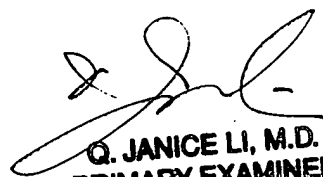
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily

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JH



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PRIMARY EXAMINER